



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/696,153	10/28/2003	Eric M. Lunsford	PALM-0933	6590

30554 7590 03/17/2005

SHEMWELL GREGORY & COURTNEY LLP
4880 STEVENS CREEK BOULEVARD
SUITE 201
SAN JOSE, CA 95129

EXAMINER

MYERS, PAUL R

ART UNIT	PAPER NUMBER
----------	--------------

2112

DATE MAILED: 03/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/696,153	Applicant(s) LUNSFORD ET AL.	
	Examiner Paul R. Myers	Art Unit 2112	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 and 30-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 30-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>12/20/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 12/20/04 have been fully considered but they are not persuasive.

In regards to applicants argument that Pleso teaches away from the method of claim 1: Claim 1 reads "suspending execution of at least a portion of a program, the portion of the program reducing power consumption of the portable computing device." This is stopping execution of the portion or the program that reduces the power consumption. Pleso teaches stopping execution of the power reducing portion of the program and resuming full power mode. If applicants amended the claim language to read "executing a portion of a program, reducing power consumption of the portable computing device" or "suspending execution of at least a portion of a program, the suspending execution of the at least a portion of a program, reducing power consumption of the portable computing device" Then this part of the claim language would read in accordance with the applicants arguments. The examiner further notes Pleso teaches "detecting a signal on the signal line to determine whether the communication device is actively connected to a portable computing device; (and if it is not actively connected) reducing the power consumption of the portable computing device". Since the claim language is also silent as to which result of the determining step (there or not there) causes the suspension.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed.

Art Unit: 2112

Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-10 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13 of U.S. Patent No. 6,523,124. Although the conflicting claims are not identical, they are not patentably distinct from each other because the pending claims merely remove limitations of the allowed claims. See *In re Emert* No. 96-1559 U.S. CAFC 44 U.S.P.Q.2D (BNA) 1149.

4. Claims 30-35 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13 of U.S. Patent No. 6,523,124 in view of Lein et al PN 5,386,567.

In regards to claims 30-35: PN 6,523,124 claims the same invention of the current application. The claims of PN 6,523,124 is silent as to the newly added auto configuration. Lein et al teaches the claimed auto configuration method (Figure 7). It would have been obvious to a person of ordinary skill in the art at the time of the invention to include the claimed auto configuration because this would have prevented requiring manual configuration.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

6. Claims 1-10 are rejected under 35 U.S.C. 102(e) as being anticipated by Pleso PN 5,859,970.

In regards to claim 1: Pleso discloses a method for operating a portable computing device (portable electronic device), the method comprising: coupling a signal line accessible through an outlet (an electrical connector) of the portable computing device to a communication device(docking station Column 2 lines 40-43); detecting a signal on the signal line to determine whether the communication device is actively connected to a portable computing device (e.g. detecting power received by the portable device from the docking station Column 2 lines 45-48, Column 6 line 59 to Column 7 line 15), and suspending execution of at least a portion of a program the portion of the program reducing power consumption of the portable computing

Art Unit: 2112

device (switches from low power consumption mode to an active full power mode Column 2 lines 49-50).

In regards to claim 2: Pleso teaches suspending execution of a portion of a program for reducing power consumption includes suspending of a timeout feature (Column 2 lines 49-50).

In regards to claim 3: Pleso teaches sending communications from the portable computing device using the communication device when the communication device is actively connected to the portable computing device (Column 2 lines 45-47, Column 5 lines 9-42).

In regards to claim 4: Pleso teaches coupling a signal line including extending the signal line to a pin connector forming the outlet (Column 5 lines 9-26).

In regards to claim 5: Pleso teaches selectively suspending the occurrence of the time-out feature when the portable computing device is actively coupled (selectively switchable from low power consumption mode to full power mode Column 6 lines 45-58).

In regards to claim 6: Pleso teaches suspending execution of at least a portion of a program for reducing power consumption of the portable computing device includes disabling the time-out feature while the communication device is actively coupled (Column 6 lines 45-58).

In regards to claim 7: Pleso teaches detecting the signal includes measuring a voltage level of the signal (Column 7 lines 1-16).

In regards to claim 8: Pleso teaches detecting a signal from the communication device includes coupling the portable computing device to the communication device using a pin connector, and wherein one pin in the pin connector extends into the signal line (Column 5 lines 9-27).

In regards to claim 9: Pleso teaches launching a program that is downloaded to the portable computing device through the communication device once the occurrence of the time-out feature is suspended (Column 5 to Column 6 line 43).

In regards to claim 10: a plurality of images are within the teachings of Pleso in that Pleso discloses a display 14 for displaying any information downloadable through the LAN or stored in the memory of the portable computing device (Column 1 and Column 6).

7. Claim 36 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by Lein et al PN 5,389,567.

In regards to claim 36: Lein et al teaches A method for operating a portable computing device (1) , comprising: automatically determining whether an accessory device is communicatively coupled to the portable computing device (S1); automatically determining a type of accessory device communicatively device coupled to the portable computing device (S4 and S6); and based on the type of accessory device, executing at least one program (S8).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 30-35, 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pleso PN 5,859,970 in view of Lein et al PN 5,386,567.

Art Unit: 2112

In regards to claim 30: Pleso teaches the sleep mode processing described above including device detection. Pleso does not teach the claimed auto configuration including determining a type of the communication device. Lein et al teaches determining the type of communication device (Figure 7 step S4 and S6). It would have been obvious to a person of ordinary skill in the art at the time of the invention to include the claimed auto configuration because this would have prevented requiring manual configuration.

In regards to claim 31: Lein et al teaches including configuring software executable on the portable computing device based on the type of the communication device (S8).

In regards to claim 32: Pleso teaches determining if power is supplied.

In regards to claim 33, 39: Pleso teaches supplying the expected power.

In regards to claims 34-35: Both Pleso and Lein et al teach a display. Both Pleso and Lein are silent as to whether the display is at maximum illumination level. Official notice is taken that setting a display to its maximum illumination level is well known. It would have been obvious to set the illumination level to maximum because this would have allowed a person who has poor eye sight see the display.

10. Claims 37-38, 40-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lein et al PN 5,386,567.

In regards to claims 37-38, 40-41: Lein et al teach a display. Lein are silent as to whether the display is at maximum illumination level. Official notice is taken that setting a display to its maximum illumination level is well known. It would have been obvious to set the

Art Unit: 2112

illumination level to maximum because this would have allowed a person who has poor eye sight see the display.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul R. Myers whose telephone number is 703 305 9656. The examiner can normally be reached on Mon-Thur 6:30-4:00.

Art Unit: 2112

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Rinehart can be reached on 703 305 4815. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PRM
September 28, 2004



PAUL R. MYERS
PRIMARY EXAMINER